

REMARKS

Claims 1-23 were pending in this application.

Claims 1-23 have been rejected.

Claims 1, 9, and 17 have been amended as shown above.

Claims 8 and 16 have been cancelled.

Claims 24 and 25 have been added.

Claims 1-7, 9-15, and 17-25 are now pending in this application.

Reconsideration and full allowance of Claims 1-7, 9-15, and 17-25 are respectfully requested.

I. REJECTION UNDER 35 U.S.C. § 102

The Office Action rejects Claims 1-5, 9-13, and 17-21 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,785,817 to Bacon et al. ("*Bacon*"). This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. (*MPEP* § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. (*MPEP* § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985)).

Bacon recites a reprogrammable subscriber terminal for subscription television services. (*Abstract*). The subscriber terminal may receive a command called a "parameters transaction,"

which identifies whether a control program in the subscriber terminal should be changed. (*Col. 2, Lines 41-57*). If so, the subscriber terminal receives and stores program code in a memory location specified by the parameters transaction. (*Col. 3, Lines 33-63*). The control program in the subscriber terminal is then reset to execute the received program code. (*Abstract*).

Claims 1, 9, and 17 have been amended to recite that a microcontroller switches from a “first operating mode” (where it executes an “embedded control program” in a ROM) to a “second operating mode” (where it executes a “downloadable software control program” in a RAM in place of the embedded control program) when an “external processing system” stores a “jump address” to the RAM in a first of a “plurality of control registers” in the microcontroller.

Bacon lacks any mention of switching modes (from executing an “embedded control program” in a ROM to executing a “downloadable software control program” in a RAM) by having an “external processing system” store a “jump address” in a “control register” of a microcontroller.

The Office Action asserts that *Bacon* discloses these elements at column 11, lines 1-10. (*Office Action, Page 5, Fifth paragraph*). The cited portion of *Bacon* lacks any mention of using a “control register” to switch “operating modes,” where different “control programs” are executed in the different operating modes. Rather, the cited portion of *Bacon* simply recites that a subscriber terminal may have internal or external memory, where internal memory is fixed and external memory includes removable memory. (*Col. 11, Lines 1-6*). The cited portion of *Bacon* also simply recites that the removable memory could be coupled to the subscriber terminal using an expansion connector, such as an expansion card connector or individual plug-in connectors. (*Col. 11, Lines 6-10*).

The cited portion of *Bacon* says absolutely nothing about any type of “control registers” in a microcontroller. The cited portion of *Bacon* also says absolutely nothing about switching the “operating modes” of the microcontroller using one of the control registers, where different “control programs” are executed in the different operating modes. In addition, the cited portion of *Bacon* says absolutely nothing about storing a “jump address” in one of the control registers. As a result, the cited portion of *Bacon* fails to anticipate switching a microcontroller from a “first operating mode” (where it executes an “embedded control program” in a ROM) to a “second operating mode” (where it executes a “downloadable software control program” in a RAM in place of the embedded control program) when an “external processing system” stores a “jump address” to the RAM in a first of a “plurality of control registers” in the microcontroller as recited in Claims 1, 9, and 17.

For these reasons, *Bacon* fails to anticipate the Applicants’ invention as recited in Claims 1, 9, and 17 (and their dependent claims). Accordingly, the Applicants respectfully request withdrawal of the § 102 rejection and full allowance of Claims 1-5, 9-13, and 17-21.

II. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 6, 7, 14, 15, 22, and 23 under 35 U.S.C. § 103(a) as being unpatentable over *Bacon* in view of U.S. Patent No. 6,859,825 to Williams (“*Williams*”). This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP* § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a *prima*

facie basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the Applicant to produce evidence of nonobviousness. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the Applicant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant's disclosure. (*MPEP* § 2142).

As shown above in Section I, Claims 1, 9, and 17 are patentable over *Bacon*. As a result, Claims 6, 7, 14, 15, 22, and 23 are patentable due to their dependence from allowable base claims.

Accordingly, the Applicants respectfully request withdrawal of the § 103 rejection and full allowance of Claims 6, 7, 14, 15, 22, and 23.

III. NEW CLAIMS

The Applicants have added new Claims 24 and 25. The Applicants respectfully submit that no new matter has been added. At a minimum, the Applicants respectfully submit that Claims 24 and 25 are patentable for the reasons discussed above. The Applicants respectfully request entry and full allowance of Claims 24 and 25.

IV. CONCLUSION

The Applicants respectfully assert that all pending claims in this application are in condition for allowance and respectfully request an early allowance of such claims.

SUMMARY


If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned attorney at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any fees connected with this communication (including any extension of time fees) or credit any overpayment to the Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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